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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/020,924 | 12/19/2001 | Francis Emmerson | 042933/306334 | 8863 |
| 826 | 7590 | 06/20/2007 | | |
| ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000 | | | EXAMINER SAGER, MARK ALAN | |
| | | | ART UNIT 3714 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/020,924

Applicant(s)

EMMERSON ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because multiple paragraphs (as depicted in marked up copy of 8/14/03 substitute specification; whereby substitute specification lacked a clean copy of abstract to discern whether formatted with multiple paragraphs). Correction is required. See MPEP § 608.01(b).
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: remove/removing the one or more selected parameters as particularly claimed. It is noted page 4 of substitute specification indicates once the team is transferred from the phone to the server, data representing the team is removed from the phone; however, the detailed description lacks further discussion (i.e. copy particular claim language or cited paraphrased text into detailed description). No new matter may be entered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the removing of one or more selected gaming parameters from the device/phone, as claimed, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 6-12 and 14-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshikawa (JP 11-019337), hereafter Yoshikawa. This holding is maintained from prior action for cited claims as amended and is reiterated next. Response to Applicant's remarks is provided below and incorporated herein. Yoshikawa discloses a networking gaming system and portable game machine that includes method, client-server system, gaming device and computer program product on a terminal/server teaching all steps/features of cited claims including games content (ROM 8 stores game content) of a mobile phone (fig. 3, ref 4) comprising gaming parameters including character type parameters (paragraph 9 and 12), sending one or more selected gaming parameters from the mobile phone by wireless transmission signals to a remote server (abstract, paragraphs 6, 9, and 12-14, figs. 1-7, esp. 1-3), at the server and outside control of a user of the mobile phone, applying training data that includes an algorithm to the one or more selected gaming parameters to provide a modified parameter set in which selected gaming parameters is modified (paragraph

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14 and 18), sending the games content of the mobile phone using the modified parameter set so as to modify play of a game by a user of the mobile phone from play of the game before sending the one or more selected gaming parameters (paragraph 14 and 18). Further, from the disclosure, the cordless handset of Yoshikawa appears to be functioning as a handheld games console in that a game program is loaded or downloaded into the handset for playing a game viewed on the handset. Also, from the machine translation Yoshikawa states in part at paragraph 14 'And in a host computer 1 side, a certain change will be given to the registered DNA data, for example, character, biorhythm pattern, etc. are changed. On the other hand, since a character will not exist in a hand held game machine 3 side, a play person chooses a training vicarious execution function, needs to take a character and needs to return after that' which when interpreted as a whole by an artisan in context of the disclosed 'JP11-019337 invention to mean that character including its gaming parameters of DNA data is removed from the phone after transfer to the server so as to teach/suggest to an artisan that Yoshikawa teaches claimed invention as amended to include to remove the one or more selected gaming parameters [e.g. DNA data] from the mobile phone such that the gaming parameters [DNA data] as well as the character is removed upon their transfer to server. Finally, it is notoriously well known [by Official Notice] so as to be hornbook engineering at a time prior to invention to clear or reset memory [location(s)] in preparation for receipt of new data so as to avoid corruption of data which may occur when new data over-writes old data especially in instances when transmission is lost or dropped; whereby, the clearing or resetting of memory assists to preclude data corruption during lost or dropped transmission. An inventor needs only to disclose that material which is new and preferably omits discussion regarding material that is old or conventional. Similarly, Yoshikawa did not discuss

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removing gaming parameters from memory after transfer to server and prior to receipt of new data since it was not new material but rather conventional so as to preclude corrupting data.

Thus, Yoshikawa includes clearing/erasing the memory locations where the character gaming parameters were stored after sending character gaming parameters to server in order to preclude data corruption, such as during lost or dropped communication. Alternatively, it would have been obvious to an artisan at a time prior to the invention to add 'to remove the one or more selected gaming parameters from the mobile phone', as particularly claimed, as hornbook engineering to Yoshikawa in order to preclude data corruption, such as during lost or dropped communication.

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa in view of Fujioka et al (6270402). This holding is maintained from prior action for cited claims as amended and is reiterated next. Response to Applicant's remarks is provided below and incorporated herein. Yoshikawa discloses claimed method (sic) except a team. However, a game involving a team, team play or forming a team is notoriously well known (by Official Notice) such as in a sport simulation [i.e. John Madden Football games, Tony LaRossa Baseball games]. Fujioka discloses a video game device and control method teaching a game involving a team, team play or forming a team that involves gaming parameters (abstract, 1:51-2:48, 11:65-15:8, figs. 1-21). Thus, it would have been obvious to an artisan at a time prior to the invention to add a team as notoriously well known or as taught by Fujioka to Yoshikawa to provide increase enjoyment for those players with preference for team play/sports or team competition.

6. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa in view of Ng. This holding is maintained from prior action for cited claims as

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amended and is reiterated next. Response to Applicant's remarks is provided below and incorporated herein. Alternatively, where a cordless handset is not a games console or personal computer, Yoshikawa discloses a gaming device (sic) except a games console or personal computer (clm 11) or wired (clm 13). A personal computer or a games console is notoriously well known (by Official Notice) [i.e. Atari, Nintendo GameBoy, Nintendo Entertainment System (NES) or Super NES or Nintendo 64 or Sony PlayStation for gaming consoles or IBM or Apple or Hewlett Packard or Bell for personal computers] for permitting games to be played from memory medium read by a games console connected to a television or monitor. It would have been obvious to an artisan at a time prior to the invention to add a games console as notoriously well known to Yoshikawa so as to increase accessibility for game play such as for those player whom may have a games console, but not a mobile phone. Further, Ng discloses a gaming device including a personal computer (1:66-2:610, 8:31-11:10, fig. 1B, ref. 27) connected to a server where gaming parameters and updated gaming parameters are transmitted by signals through wired networks for remotely connecting to a server (3:56-4:9). Also regarding wired, there is only two forms of communication, i.e. wired or wireless. Although, Yoshikawa discloses wireless communication, the manner of communication does not teach away from claimed invention of communication being wired when an artisan considers the art at a time prior to the invention as a whole. Thus, it would have been obvious to an artisan at a time prior to the invention to add a games console or personal computer and wired as notoriously well known or as taught by Ng to Yoshikawa so as to increase accessibility since some player/users prefer or have access to play on PCs or games consoles over wired networks.

Response to Arguments

7. Applicant's arguments filed 4/06/07 have been fully considered but they are not persuasive. It is noted that holding is based upon best understanding of machine translation of foreign references. Applicant asserts that Nobuaki Yoshikawa fails to teach/suggest 'sending one or more gaming parameters from the mobile phone to a remote server to remove the one or more selected gaming parameters from the mobile phone; but the examiner disagrees with Applicants interpretation of translated reference. The examiner maintains Yoshikawa teaches or suggests claimed invention. For instance the machine translation of Yoshikawa states the character does not exist on the hand held phone side (after transfer to server since prior sentence in translated paragraph pertained to data having been transferred to server) that is interpreted to mean character is transferred to server for training for updating of DNA data and the character is removed so as to not exist on the hand held phone side as stated in holding above. Also, it was hornbook engineering to an artisan at a time prior to invention to clear memory in preparation of saving new data so as to preclude corruption of new data, such as during lost or dropped transmission; such that it is held that Yoshikawa either includes clearing/resetting of memory in preparation of receiving new data as known or deemed obvious to include clearing/resetting of memory in preparation of receiving new data so as to preclude corrupting data such as from lost or dropped transmission. Applicant also asserts patentability regarding claims 4-5 based upon remark cited above that Yoshikawa lacks removing gaming parameters from device, thus reply above is incorporated herein. However, Applicant provided no response with respect to obviousness of Yoshikawa in view of Ng for claims 11 and 13; however, the office maintains holding based upon assertions discussed above regarding Yoshikawa incorporated herein.

Conclusion

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

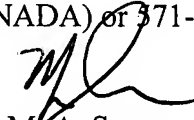
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 371-272-1000.



M. A. Sager
Primary Examiner
Art Unit 3714

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